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REMARKS/ARGUMENTS

Claims 1-7 are pending in this application.

Claims 1-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Masaaki et al. (JP 61-6919). Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Masaaki et al. in view of Michio et al. (JP 2000-059175).

Applicants respectfully traverse the rejections of claims 1-7.

Claim 1 recites:

"A method for adjusting a frequency characteristic of an edge reflection type surface acoustic wave device, comprising the steps of:
determining the frequency characteristic of a first edge reflection type surface acoustic wave device having a piezoelectric substrate that is a first edge reflection type surface acoustic wave device cut from a piezoelectric wafer, the first edge reflection type surface acoustic wave device having a pair of edges of the piezoelectric substrate which define a predetermined distance therebetween; and

cutting the piezoelectric wafer for additional edge reflection type surface acoustic wave devices, which are subsequently cut from the piezoelectric wafer after the first edge reflection type surface acoustic wave device is cut, at at least one of a pair of positions which define a distance that is shorter than the predetermined distance when a final frequency characteristic of the additional edge reflection type surface acoustic wave devices is to be higher than an obtained frequency characteristic of the first edge reflection type surface acoustic wave device, and cutting the piezoelectric wafer at at least one of a pair of positions which define a distance that is longer than the predetermined distance when a final frequency characteristic of the additional edge reflection type surface acoustic wave devices is to be lower than the obtained frequency characteristic." (emphasis added)

The Examiner acknowledged that Masaaki et al. fails to teach or suggest the processing step of cutting the additional edge reflection type surface acoustic wave devices either longer or shorter from the piezoelectric wafer. However, the Examiner inexplicably concluded that it would have been obvious "to modify a process of fabricating the additional edge reflection type surface acoustic wave device of Masaaki

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et al. by longer or shorter [than] the predetermined distance from the piezoelectric wafer in order to obtain desired value of the frequency of the edge reflection type surface acoustic wave device." Applicants respectfully disagree.

First, the Examiner admits that Masaaki et al. fails to teach or suggest anything at all about cutting additional edge reflection type surface acoustic wave devices. Without any support or evidence, the Examiner concludes that Applicants' claimed cutting step is somehow obvious.

The Examiner is reminded that prior art rejections must be based on evidence. Graham v. John Deere Co., 383 U.S. 117 (1966). The Examiner is hereby requested to cite a reference in support of his position that it was well known at the time of Applicants' invention to "modify a process of fabricating the additional edge reflection type surface acoustic wave device of Masaaki et al. by longer or shorter [than] the predetermined distance from the piezoelectric wafer in order to obtain desired value of the frequency of the edge reflection type surface acoustic wave device." If the rejection is based on facts within the personal knowledge of the Examiner, the data should be supported as specifically as possible and the rejection must be supported by an affidavit from the Examiner, which would be subject to contradiction or explanation by affidavit of Applicants or other persons. See 37 C.F.R. § 1.104(d)(2).

The PTO has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. See In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1984). This it has not done. The Examiner failed to cite prior art that remedies the deficiencies of Masaaki et al. or that suggests the obviousness of modifying Masaaki et al. to achieve Applicants' claimed invention.

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Instead, the Examiner improperly relied upon hindsight reconstruction of the claimed invention in reaching his obviousness determination. To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1543, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

Second, the Examiner alleged that Masaaki et al. teaches:

"a process of adjusting a frequency of an edge reflection type surface acoustic wave device comprising a process of determining a frequency characteristic of a first edge reflection type surface acoustic wave device (2) having a piezoelectric substrate (1) that is the first edge reflection type surface acoustic wave device cut from a piezoelectric wafer (1a), the edge reflection type surface acoustic wave device having a pair of edges of the piezoelectric substrate which define a predetermined distance therebetween (such as $\lambda/2$) as shown in Fig. 5 and a process of cutting the piezoelectric wafer for additional edge reflection type surface acoustic wave device[s], which are subsequently cut from the piezoelectric wafer after the first edge reflection type surface acoustic wave device is cut (as shown in Fig. 2). According to Fig. 9 of Masaaki et al., the frequency characteristic of the edge reflection type surface acoustic wave device is to be higher when a distance of at least one of a pair of positions is shorter than the predetermined distance, and the frequency characteristic of the edge reflection type surface acoustic wave device is to be lower when a distance of at least one of a pair of positions is longer than the predetermined distance."

Applicants are completely bewildered by the Examiner's interpretation of the alleged teachings of Masaaki et al. Contrary to the Examiner's allegations, Figs. 2 and 5 of Masaaki et al. fail to teach or suggest anything at all about cutting the piezoelectric wafer 1a for additional edge reflection type surface acoustic wave devices. In contrast, Figs. 2 and 5 of Masaaki et al. merely show different views of a single surface acoustic wave device which is cut from the piezoelectric wafer 1a. Masaaki et al. fails to

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teach or suggest any step of cutting the piezoelectric wafer 1a for additional edge reflection type surface acoustic wave devices.

Fig. 9 of Masaaki et al. merely shows that different frequency characteristics are caused when the piezoelectric wafer 1a is cut at positions that deviate from desired cutting positions. Neither Fig. 9 of Masaaki et al., nor any other figure of Masaaki et al., teaches anything at all about cutting a piezoelectric substrate for **additional edge reflection type surface acoustic wave devices**. Thus, Masaaki et al. certainly fails to teach or suggest the step of "cutting the piezoelectric wafer for additional edge reflection type surface acoustic wave devices, which are subsequently cut from the piezoelectric wafer after the first edge reflection type surface acoustic wave device is cut, at at least one of a pair of positions which define a distance that is shorter than the predetermined distance when a final frequency characteristic of the additional edge reflection type surface acoustic wave devices is to be higher than an obtained frequency characteristic of the first edge reflection type surface acoustic wave device, and cutting the piezoelectric wafer at at least one of a pair of positions which define a distance that is longer than the predetermined distance when a final frequency characteristic of the additional edge reflection type surface acoustic wave devices is to be lower than the obtained frequency characteristic" as recited in Applicants' claim 1.

Applicants hereby request that the Examiner provide an English language translation of Masaaki et al. "so that the record is clear as to the precise facts the examiner is relying upon." MPEP § 706.02, "Reliance upon Abstracts and Foreign Language Documents in Support of a Rejection;" See also Ex parte Jones, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001). Since, as described above, the figures of Masaaki et al. clearly fail to teach or suggest the method steps and features that the Examiner has alleged, Applicants respectfully submit that, without an English language translation of Masaaki et al, the record is definitely **not** clear as to the precise facts the Examiner is relying upon.

Accordingly, Applicants respectfully request reconsideration and withdrawal of

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the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Masaaki et al.

The Examiner has relied upon Michio et al. to allegedly cure deficiencies of Masaaki et al. However, Michio et al. clearly fails to teach or suggest the step of "cutting the piezoelectric wafer for additional edge reflection type surface acoustic wave devices, which are subsequently cut from the piezoelectric wafer after the first edge reflection type surface acoustic wave device is cut, at at least one of a pair of positions which define a distance that is shorter than the predetermined distance when a final frequency characteristic of the additional edge reflection type surface acoustic wave devices is to be higher than an obtained frequency characteristic of the first edge reflection type surface acoustic wave device, and cutting the piezoelectric wafer at at least one of a pair of positions which define a distance that is longer than the predetermined distance when a final frequency characteristic of the additional edge reflection type surface acoustic wave devices is to be lower than the obtained frequency characteristic" as recited in Applicants' claim 1. Thus, Applicants respectfully submit that Michio et al. fails to cure the deficiencies of Masaaki et al. described above.

Accordingly, Applicants respectfully submit that Masaaki et al. and Michio et al., applied alone or in combination, fail to teach or suggest the unique combination of method steps and features recited in Applicants' claim 1.

In view of the foregoing remarks, Applicants respectfully submit that claim 1 is allowable. Claims 2-7 depend upon claim 1, and are therefore allowable for at least the reasons that claim 1 is allowable.

In view of the foregoing remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicants petition the Commissioner for a One-month extension of time, extending to August 19, 2005, the period for response to the Office Action dated April 19, 2005.

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The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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